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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,023	01/10/2002	Toshihiro Morita	275730US6PCT	4611
22850 7590 07/21/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHEN, TE Y	
			ART UNIT 2161	PAPER NUMBER
			NOTIFICATION DATE 07/21/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/889,023	<b>Applicant(s)</b> MORITA ET AL.	
	<b>Examiner</b> SUSAN Y. CHEN	<b>Art Unit</b> 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-43 and 48-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-43 and 48-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Amendment***

This office action is in response to the amendment filed on April 24, 2009.

Claims 41-43 and 48-69 are pending for examination. Claims 41, 48, 53, 55, 60, 62, 67 and 68 have been amended; claims 1-40, 44-47 and 70 have been canceled.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41-43 and 48-69, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,412,012 issued to Bieganski et al. (hereinafter referred as Bieganski).

Claims 41, 48, 53, 55, 60, 62 and 67-68:

Bieganski discloses an information processing system as claimed [e.g., Fig. 1] comprising:

- a recording unit for recording usage history data and the related data recorded in the recording means based on at least two filtering data set, wherein, each of the at least two filtering dataset

defining a filtering criteria as a computation of a weight per each contents. [e.g., the CPU (102, Fig. 1) can coupled to the memory system (104, Fig. 1) and the secondary storage (108 of Fig. 1) to log history data indicative of usage history of the group of contents. Furthermore, the data being stored in the History Set (203, Fig. 2) and the customer's behavior data recorded at a shopping set as specified at col. 8, lines 7-8, and the Purchased Items associated to a particular user's Transaction, and the item compatibility rule data sets at (900, Fig. 9), and the recommendation sets generated by the engine (600, Fig. 14; col. 14, lines 31-33), wherein the at least two filtering data set (e.g., the units: 303, 305, 306, Fig. 3 and associated texts) are deemed to define as filtering criteria as a computation of a weight per each contents in the recommendation set (e.g., col. 3, lines 48-58)];

- a filtering criteria setting units configured to set the filtering data sets based on the history data input by a user (e.g., the compatibility filtered and weighted recommendation based on the user input preference data and the item compatibility rules at col. 3, lines 48 -67, Fig. 4A-B and associated texts)
- a computing unit configured to compute a weight per each of the contents based on both the history data and one of the at least two filtering data sets set by the filtering criteria setting unit [e.g.,

the compatibility modifier (200, Fig. 2) of the collaborative filtering system will accept a stored number of checkout (or the number of times each item was purchased as shown by Fig. 9) per each of the contents from the history data on a filtering rule specified by a marketer or customer or the processing of recommendation engine itself (col. 9, lines 63-49) and other filtering criteria form the units such as 201, 202, 203, 204 of Fig. 2 to compute a weight related to the number of checkout (the steps 752-756, Fig. 7A)], wherein the filtering criteria of the at least two filtering data sets were entered by a user operation the information processor [e.g., the collaborative filtering systems at col. 6, lines 4-6, Fig. 2 and associated texts];

- a selecting unit for selecting a content from the group of contents based on weight computed by the computing means and to create at least two filtering packages which are different combinations of the contents from the group of contents, each of the at least two filtering package represents a list of content identification information identifying the content selected [e.g., the user interface adapter coupled to the Input Device (114, 118, Fig 1) can be used to select the modified recommendation set based on weight computed by the compatibility modifier, since users of the system are different, their preferences (or selections) from the

group of contents in each of customized packages based on weight will be different, wherein these packages can be identified by a set of customer-item pairs or in form of a 3-tuples (i.e., customer identifier, item identifier, and preference value) at col. 2, lines 4 – 25 or by the complement set identification at 409, Fig. 4B and associated texts];

- a displaying unit configured to display the group of contents and the at least two filtering packages representing the list including the combinations of contents [e.g., the Display Adapter (112, Fig. 1) coupled to the Display Device (116, Fig. 1) can display a list of recommended books selected by the book reviewers (col. 7, lines 46-64) or display compatibility modifier recommendations at col. 17, lines 48 -58 or using the web browser/server as shown in Fig. 11]; and
- a reproducing unit configured to reproduce the content included in a filtering package read from the recording unit if the user selects the content in the list of the filtering package [e.g., the processing of compatibility-aware recommendation engines 1110 and 1212 at col. 18, lines 33 – col. 19, lines 43, Fig. 11 – 12 and associated texts].

As to claims 42, 49, 51-52, 54, 56, 58-59, 61, 63, and 65-66:

Except all the features recited in claims 41, 48, 53, 55, 60, and 62, Bieganski further disclose that the computing unit computes per each of the contents a weight about a period for which the content has been checked out or for the genre of the content or for playing time of the content [e.g., Fig. 9 and associated texts].

As to claim 69, except the limitations recited in claim 1, Bieganski further discloses that the recording unit is configured to change the filtering data in the filtering file to values input by the user [e.g., Bieganski: the use of I/O adaptor 106, Fig. 1 and associated texts].

### ***Response to Arguments***

Applicant's arguments based on newly amended limitations with respect to claims 41-43 and 48-69 have been considered but are moot in view of the new ground(s) of rejection.

The examiner disagrees with applicant's arguments that Bieganski failed to disclose the claimed selection unit and reproducing unit.

In response to applicant's arguments the examiner directs applicant's attention to the following depicts and Figures disclosed by Bieganski:

For example, Bieganski clearly cited a user interface adapter (106, Fig. 1) coupled to the Input Device (114, 118, Fig 1) which can be used to select the modified recommendation set based on weight computed by the compatibility modifier, since users of the system are different, their preferences (or selections) from the group of

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contents in each of customized packages based on weight will be different, wherein these packages can be identified by a set of customer-item pairs or in form of a 3-tuples (i.e., customer identifier, item identifier, and preference value) at col. 2, lines 4 – 25 or by the complement set identification at 409, Fig. 4B and associated texts. Thus, the user interface adapted coupled to the input device with the selection utilities read on the claimed selection unit by applicant.

Further, Bieganski clearly disclosed the claimed reproducing unit with the function as claimed. For example, Bieganski clearly depicts the processing of compatibility-aware recommendation engines such as the units: 1110 and 1212 at col. 18, lines 33 – col. 19, lines 43 that perform the claimed functions to reproduce the content included in a filtering package read from the recording unit if the user selects the content in the list of the filtering package [please also refer to Fig. 11 – 12 and associated texts]. Thereby, as set forth above, in contrary to applicant arguments, Bieganski fully anticipated the claimed limitations.

Because applicant either argued based on newly amended features that are moot on the new ground rejections or fail to clearly distinguish the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The examiner concludes that the prior art read on the claimed features.



### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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/Susan Y Chen/  
Partial Sig. Examiner  
Art Unit 2161

July 16, 2009

/Apu M Mofiz/  
Supervisory Patent Examiner, Art Unit 2161